

REMARKS

Claims 1-19 are currently pending for the Examiner's consideration, with claims 1 and 14 being the independent claims. The Examiner has required restriction between the following two groups of claims:

Group I: Claims 1-17, drawn to a composition for sustained release of a biologically active polypeptide; and

Group II: Claims 18-19, drawn to a method of treating a patient suffering from Type 2 Diabetes.

Applicants have elected Group I, claims 1-17, for continued examination. The elected claims are directed to the composition, or "product." As recognized by the Examiner on page 3 of the Office Action, "[I]nventions I and II are related as product and process of use." Because the Examiner has required restriction between product and process claims, and Applicants have elected the claims directed to the product, once the product claims are found allowable, withdrawn process claims that depend from or otherwise require all the limitations of an allowable product claim are eligible for rejoinder. *See* M.P.E.P. § 821.04. Withdrawn process claims 18 and 19 depend from product claims 1 and 14, respectively.

Election of Species

In addition to the Restriction Requirement, the outstanding Office Action includes an Election of Species requirement. Applicants respectfully traverse because the Examiner has provided no rationale for this requirement. The Examiner states on page 2 of the Office Action that "[S]ince the previous examiner of record does not appear to have examined all the inventions claimed in the application, it is deemed that searching all the product claims would indeed constitute a burdensome search." As an initial matter, the prosecution record prior to the issuance of the present Office Action is contrary to the Examiner's statement. In particular, the Final Office Action dated December 12, 2006 rejected all of claims 1-17 on the merits, and, therefore, the previous examiner did "examine all the inventions claimed" in product claims 1-17. Second, the fact that the previous examiner did not require an election of species does not

mean that “all the inventions claimed in the application” were not examined. Finally, the view of the present Examiner regarding the scope of examination by the previous examiner does not provide a well-reasoned justification for the conclusion “that searching all the product claims would indeed constitute a burdensome search.” The Examiner has provided no reason why there is a “burdensome search;” instead, the Examiner has merely “deemed” that this is the case.

The Examiner has required an election of species for each of the following: (i) a biocompatible polymer; (ii) a glucoregulatory peptide; and (iii) a sugar. Applicants hereby elect the following: (i) poly(lactide-co-glycolide) polymer; (ii) exendin-4; and (iii) sucrose. Applicants respectfully submit that all of elected claims 1-17 read on each of the three elected species, and, as such, each of claims 1-17 is generic.

Other Matters

Enclosed is a copy of a Change of Correspondence Address that was filed on November 8, 2006. The Examiner is requested to ensure that the Change of Correspondence Address is implemented to ensure timely and proper written communication with Applicants.

In addition, an Information Disclosure Statement was filed on May 25, 2007. The Examiner is requested to consider the cited documents, and return a copy of the initialed Form PTO/SB/08A/B with the next communication to Applicants.

CONCLUSION

Prompt and favorable consideration of this response is respectfully requested.

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Dated: July 10, 2007

Respectfully submitted,

By 

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